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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/520,476	03/08/2000	Aslam A. Malik	04906-013843	2209

7590 02/27/2004

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EXAMINER

REDDICK, MARIE L

ART UNIT PAPER NUMBER

1713

DATE MAILED: 02/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/520,476

Applicant(s)

MALIK ET AL. *eb*

Examiner

Judy M. Reddick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05/12/03;12/15/03;12/22/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-28 is/are rejected.
- 7) ☒ Claim(s) 27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/15/03 has been entered.

Oath/Declaration

2. The supplemental oath filed on 09/26/02 & 12/15/03 and executed by the named inventors of the above-referenced patent application is in compliance with 37 CFR 1.67.

Drawings

3. The drawings filed on 06/12/00 are acceptable for examination purposes only.

Claim Objections

4. Claim 27 is objected to because of the following informalities: Claim 27 exists in duplicate. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 20-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) The recited "general formulae" per claim 20 constitutes indefinite subject matter as per it not being apparent if or how said objectionable term "general" further limits the claims, said term being relative and not absolute.

B) The recited "R₁" per claim 1 constitutes indefinite subject matter as per the non-express establishment of proper antecedent basis.

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Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 20-26 and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Hargis et al(U.S. 5,674,951).

Hargis et al disclose polyurethane elastomers comprising monomeric repeat units such as are instantly claimed(see the claims). Specific examples of the FOX monomers are shown in the examples and Hargis et al specifically teach that these oxetane monomers may also be copolymers with tetrahydrofuran(col. 12, lines 18-21). The polyisocyanates taught to be used also include those such as are used in the instant invention(col. 4, lines 52-65). The use of cross-linking agents such as are used and claimed in the instant invention are taught(col. 5, line 31 to col. 6, line 12), and the use of liquid hydroxyl intermediates such as are known in the art are taught to be used as chain extenders(col. 3, lines 55-65).

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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10. Claim 27 is rejected under 35 U.S.C. 102(e) as anticipated by Hargis et al or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hargis et al in view of Examiner's Notice.

Hargis et al, as discussed above and applied to claims 20-26 and 28 is deficient in not specifically indicating that 1,4-butanediol could be used as a chain extender. However, as indicated above, the use of liquid hydroxyl intermediates such as are known in the art are taught to be used as chain extenders. The Examiner takes Notice that the use of 1,4-butanediol is known as a chain extender in the art of polyurethane elastomers and that 1,4-butanediol meets the limitations for such polyols set forth by Hargis at col. 3, lines 55-65. It would have been obvious to the skilled artisan to use 1,4-butanediol as a chain extender in the urethane elastomers taught by Hargis for its known and intended purpose.

Response to Arguments

11. Applicant's arguments filed 12/15/03 have been fully considered but they are not persuasive.

Relative to the rejections under 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a) over Hargis et al--The executed copies of the Declarations of Aslam A. Malik, Ph.D. and Thomas G. Archibald, Ph.d are noted. However, the Declarations are insufficient to remove the rejections based on Hargis et al as per there being no documented evidence of conception and reduction to practice prior to the effective filing date of Hargis et al, viz., exhibits, records, notebook entries, etc., to support the Declarations.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (571)272-1110. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Judy M. Reddick
Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR *JMR*
02/18/04